

Attorney Docket No. SIC-04-033

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of:

TATSUYA KAWAKAMI

Application No.: 10/711,702

Filed: September 30, 2004

For: BICYCLE SHIFT DEVICE HAVING A  
LINEARLY SLIDING SHIFT LEVER  
OPERATED BY A PIVOTING  
INTERFACE MEMBER

Examiner: Vinh Luong

Art Unit: 3656

REPLY BRIEF

Commissioner for Patents  
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Commissioner:

This is a reply brief for the above-captioned matter.

The Examiner's Answer basically repeats the text of the final office action dated July 8, 2009, so the arguments presented in the Appeal Brief remain applicable. As required by the rules, this Reply Brief will be limited to new points raised in the Examiner's Answer.

**Rejection under 35 U.S.C. §112**

At page 3 of the Examiner's Answer, the Examiner alleges that the phrase in claim 25, "wherein, when the device is oriented such that the rotational axis (X) is vertical, the pivot axis (P) extends at least in part in a vertical direction," is a functional limitation. The cited text is not a functional limitation, it is a structural limitation. How the device is operated does *not* change the relationship between the rotational axis (X) and the pivot axis (P). Furthermore, while the cited text was added to determine infringement as noted at the bottom of page 12 of the Examiner's Answer (it

was added primarily to avoid possible definiteness issues), the cited text, being a structural limitation, also can be validly used to distinguish over the prior art.

In the paragraph bridging pages 3 and 4 of the Examiner's Answer, the Examiner also alleges that the Appellant is relying on principles of inherency in order to support the cited text. However, the Appellant is relying on the express teachings of the specification as filed, and specifically the elected embodiments shown in Figs. 10 and 11. In both embodiments, operating member (interface member) (434) (Fig. 10) or operating member (interface member) (444) (Fig. 11) pivots around a pivot axis (P) that is substantially perpendicular to a handlebar axis (HB), wherein pivot axis (P) is substantially *parallel* to a rotational axis (X) of a take-up body (control body) (170) (Fig. 3) that is integrally coupled to a drive plate (171) (Figs. 3, 10, 11). See paragraph [0027], lines 5-6 and paragraph [0028], lines 5-6. When rotational axis (X) is vertical, pivot axis (P) likewise is always vertical (perpendicular to the page in Figs. 10 and 11). Thus, the Examiner's statement at page 3, lines 17-18 of the Examiner's Answer that "when the device 430, 440 is oriented such that the rotational axis X is vertical, the pivot axis P *may or may not* extend at least in part in a vertical direction" is simply wrong. Based on the teachings of Figs. 10 and 11 and the text of the specification, pivot axis (P) will *always* extend vertically when rotational axis (X) is vertical.

Contrary to the statement made at page 15, lines 8-11 of the Examiner's Answer, the Appellant never admitted that there is a possibility that when the device is oriented such that the rotational axis (X) is vertical, the pivot axis (P) may not extend at least in part in a vertical direction. The Examiner relies on the Appellant's statement that "claim 25 recites a subset of inclinations" for such an admission. However, claim 25 is expressly directed to a subset of *vertical* inclinations of pivot axis (P), not a subset of all possible inclinations of pivot axis (P). A simple review of Figs. 10 and 11 shows that the Examiner's hypothetical state of pivot axis (P) is impossible.

Furthermore, while the cited specification text and Figs. 10 and 11 show a pivot axis (P) that is exactly vertical when rotational axis (X) is vertical, it is believed that the statement at the beginning of paragraph [0025] that "the pivot axis (P) could be inclined relative to the handlebar axis (HB) by any degree to accommodate different riding styles" sufficiently informs one of ordinary skill in the art that pivot axis (P) may vary from the precisely vertical position when pivot axis (X) is

precisely vertical. Thus, it should be clear that claim 25 recites a subset of *vertical* inclinations wherein, when the device is oriented such that the rotational axis (X) is vertical, the pivot axis (P) extends at least in part in a vertical direction, and one of ordinary skill in the art would immediately know that the Appellant had possession of such an invention.

When addressing this ground of rejection further at the text bridging pages 13-14 of the Examiner's Answer, the Examiner faults the Appellant for not identifying the embodiments shown in Figs. 1-7 as prior art. However, whether or not a disclosed embodiment is prior art is irrelevant to the issue of whether or not a claim feature is disclosed in the originally-filed specification. Nevertheless, because the Examiner's statements imply that a clerical error in the application somehow misled the examiner, further comment is required.

Page 14, lines 17-20 of the Examiner's Answer states:

"If Appellant had disclosed that Figs. 1-7 showed the prior art device on the filing date, the Examiner would not have required the restriction. Instead, the Examiner would have applied the admitted prior art in Figs. 1-7 to reject Appellant's claims pursuant to MPEP §2129."

First, the claims in this application NEVER covered the embodiment shown in Figs. 1-7, so the Appellant never was trying to improperly protect that embodiment. Indeed, this fact was acknowledged by the examiner when he withdrew the Section 102(b) rejection over Shahana (which disclosed the embodiment shown in Figs. 1-7) after the very first office on the merits dated April 9, 2008.

Second, as for the Examiner's handling of the restriction requirement, it is a fundamental rule of restriction practice that the Examiner must first determine whether or not related inventions are distinct. See MPEP §803(I)(A). As stated in MPEP §802.01(II):

"Related inventions are distinct if the inventions *as claimed* are not connected in at least one of design, operation, or effect (e.g., can be made by, or used in, a materially different process) and wherein at least one invention is PATENTABLE (novel and nonobvious) OVER THE OTHER (through they may each be unpatentable over the prior art)." (*emphasis in original*)

As expressly stated in the MPEP, whether or not a particular embodiment is unpatentable over the prior art (e.g., because is not novel) is expressly irrelevant to the restriction requirement analysis. The question is not whether a first embodiment is prior art, but whether or not the other embodiments are patentable over that first embodiment. It is well known that, in order to discharge such a duty, *the examiner must assume that the first embodiment is prior art* to prevent a feature in the first embodiment that the examiner may consider to be patentable and that also appears in a second embodiment from erroneously leading the examiner to think that the second embodiment is also patentable. Thus, the Examiner was *required* to assume that the embodiment shown in Figs. 1-7 was prior art relative to the other embodiments for the restriction analysis. The present Examiner has decades of experience and clearly must be aware of this fundamental requirement of restriction practice, so it is unclear why he believes that the reference to the embodiment shown in Figs. 1-7 as “according to the present invention” justifiably misled him into making an improper restriction requirement. It is also well-known that an examiner may withdraw a restriction requirement at any time, even in an Examiner’s Answer during an appeal, and an examiner may issue any new ground of rejection that he desires, even in an Examiner’s Answer during an appeal, so it is unclear why he did not do in the Examiner’s Answer what he claimed he would have done then.

In any event, the Shahana patent (US 6,450,060), a Section 102(b) reference that discloses the embodiment shown in Figs. 1-7 as noted above, was disclosed to the examiner in an Information Disclosure Statement (IDS) submitted on September 30, 2004 when the application was filed. Thus, the examiner *was* alerted to the prior art status of Figs. 1-7 *at the time the application was filed*, and was *required* to consider this prior art when conducting the restriction analysis. Thus, the statement that the Appellant did not alert the examiner of the prior art status of Figs. 1-7 at the time the application was filed is demonstrably false.

As if that wasn’t enough, the European equivalent to Shahana, EP 1,134,158, together with an accompanying European search report that listed the reference in prior art category “X,” was submitted to the Examiner in an IDS filed June 14, 2006. Thus, at the time the restriction analysis was being conducted in December 2007, the examiner was alerted *twice* to the prior art status of Figs. 1-7 as a result of the two IDS’s. Indeed, as noted in the last paragraph at page 7 of the Appeal Brief, the examiner touted the category “X” status of EP ‘158 *four times* during prosecution of this

application (and yet again at page 20 of the Examiner's Answer), so he was well aware of the prior art status of Figs. 1-7 at the time the restriction analysis was being conducted. Thus, the Examiner's statement that he had no reason to treat the embodiment of Figs. 1-7 as prior art when the Examiner made the restriction requirement of election of species on January 2, 2008 (when the Examiner also expressly acknowledged that *both* Shahana references were considered) is absurd.

In any event, as noted in the Appeal Brief, the European claims corresponding to the claims in this application were distinguished over Shahana (as EP '158) and granted long ago for the same inclined pivot axis feature recited in claim 1 of this application.

**Rejection under nonstatutory obviousness-type double patenting.**

It is clear from the Appeal Brief and the Examiner's Answer that both parties agree that the Examiner's position is that it would have been obvious to one of ordinary skill in the art to loosen the mounting bolt for mounting sleeve (103A) in the device shown in Appl. '658 so that mounting sleeve (103A) releases its grip on handlebar (101), and then to rotate mounting member (103) coaxially around handlebar (101) (rotated clockwise or counterclockwise around handlebar axis (HB) in Figs. 4 and 5 in Appl. '658). Once the device is so rotated, then, according to the Examiner, the pivot axis (P) (defined by pivot shaft (216)) will become inclined relative to the handlebar axis (HB) as recited in claim 1. However, it is clear from Figs. 4 and 5 of Appl. '658 that such coaxial rotation will *never* cause pivot axis (P) of Appl. '658 to become inclined relative to handlebar axis (HB). Pivot axis (P) will *always* remain parallel to handlebar axis (HB) during such coaxial rotation. The Examiner cannot rely on an *exploded* view of the device (Fig. 3) to claim otherwise.

The additional arguments made at pages 18-20 of the Examiner's Answer have been adequately addressed in the Appeal Brief.

Finally, at page 20, lines 8-12 of the Examiner's Answer, the Examiner makes another allegation that needs to be addressed. The Examiner found it noteworthy to point out that claims 1, 8, 18 and 19 of Appl. '658 were rejected for obviousness-type double patenting over claims 1 and 13 of this application. The Appellant filed a terminal disclaimer in that case to overcome that ground of

rejection. Thus, according to the Examiner, the Appellant *de facto* conceded the validity of the obviousness-type double patenting rejection in *this* case.

As stated in *Ortho Pharmaceutical Corp. v. Smith*, 959 F.2d 936, 941 (Fed. Cir. 1992):

“In legal principle, the filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting, and raises neither presumption nor estoppel on the merits of the rejection. It is improper to convert this simple expedient of “obviation” into an admission or acquiescence or estoppel on the merits.” (quoting *Quad Envtl. Technologies Corp. v. Union Sanitary Dist.*, 946 F.2d 870, 874 (Fed. Cir. 1991).

Thus, the Examiner’s view that the filing of a terminal disclaimer is an admission of the propriety of the underlying rejection is wrong as a matter of law.

Insofar as the Examiner’s allegation may raise extraneous issues during any subsequent enforcement of any patent that issues from this application, the circumstances surrounding that obviousness-type rejection should be made clear. Appl ‘658 is a reissue application of US Patent No. 6,450,060, the Shahana patent noted above (and the reference used in the Section 103(a) rejection discussed below). Shahana is the first-filed, first-issued, first invention of the subject matter disclosed in Figs. 1-7 in this application. In fact, Shahana issued more than a year prior to the filing date of this application and therefore is available as prior art pursuant to Section 102(b).

It is well-known and fundamental that a second issued patent may not improperly extend the term of protection for an earlier patented invention. However, by making an obviousness-type rejection in Appl. ‘658, the Examiner sought to limit the protection afforded by the *earlier patented invention*, which is absurd. The undersigned discussed the matter with the Examiner in an attempt to explain the impropriety of the Examiner’s actions, but the Examiner refused to change his position. Since the claims in Appl. ‘658 (Shahana) will expire naturally prior to any claims that issue in this case, a terminal disclaimer would have no effect on the term of the Shahana patent. Thus, a terminal disclaimer was filed as an inconsequential act to appease the Examiner and to avoid the time and great cost of an appeal, not to mention the additional burden on the Board. There certainly was no admission against interest by filing such a terminal disclaimer.

Thus, the Examiner's findings are in error, and a *prima facie* case of nonstatutory double patenting has not been established.


**Rejection under 35 U.S.C. §103(a) over Shahana.**

Page 9, lines 3-7 of the Examiner's answer again relies on the obviousness of coaxial rotation of Shahana's device around handlebar axis (HB) in order to reject the claims under §103(a). However, for the same reasons noted above, it is clear from Figs. 4 and 5 of Shahana that such coaxial rotation will *never* cause pivot axis (P) of Shahana to become inclined relative to handlebar axis (HB). Shahana's pivot axis (P) will *always* remain parallel to handlebar axis (HB) during such coaxial rotation.

At page 21, lines 5-8 of the Examiner's Answer, the Examiner states that claim 1 does not recite the mutually exclusive characteristics/patentably distinguishing structures of the species of Figs. 1 and 10. However, as noted above, claim 1 expressly recites the pivot axis (P) being inclined relative to the handlebar axis (HB), whereas pivot axis (P) in Figs. 1-7 is always parallel to handlebar axis (HB).

The remaining arguments at pages 21-26 of the Examiner's Answer merely repeat the text from pages 18-23 of the final office action dated July 8, 2009, and those arguments have been addressed in the Appeal Brief.

Respectfully submitted,



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